



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,164	04/05/2000	Gregory John Billington	07703-332001	6323

7590

05/02/2002

Fish & Richardson P.C.
45 Rockefeller Plaza
Suite 2800
New York, NY 10111

EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 05/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,164

Applicant(s)

BILLINGTON ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-20 and 25-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-20 and 25-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3653

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. It is unclear in lines 1-3 of claim 29 whether a "means for accepting payments in units of different denominations" or "means for performing vends, or "means for determining that insufficient change is available" or a "means for dispensing change" is being claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-20 and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morun (US 5,566,807). Morun discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20, 26 and 29;

1. a vending machine (1) *operable* to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further *operable* in response to determining that insufficient change is available (see figure 8, element 900), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 9, element 1002) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount (see figure 7),
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 5, elements (420 and 430));

As described in Claims 8, 17 and 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (95) (see also col. 11, lines 3-24);

As described in Claim 29;

5. the warning indication is provided only if the allowable overpay amount is non-zero (note that the warning indication as described in col. 11, lines 3-24 will not be provided where the customer submits an amount that is the price of the item desired).

As described in Claim 30;

6. said predetermined criterion is met when the available change is less than the value of the lowest denomination non-refundable payment unit (see figure 8);

As described in Claim 31;

7. said vending machine is operable to provide an "exact change" indication to a customer when a requested vend is inhibited (again, note display (95), thereby providing ability and capability to display such information);

As described in Claims 11, 28 and 32;

8. the machine is operable, when inhibiting a vend, to permit the customer to request a vend at a different price (note that the customer is capable of requesting a vend at a different price when the machine becomes disabled (1106)).

As described in Claim 13;

10. the circumstances giving rise to the second indication also cause the deposited monetary unit to be refunded (see figures 10a and 10b);

6. Claims 8-10, 12, 14-18, 20, 26 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Tedesco et al (US 6,085,888). Tedesco et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20, 26 and 29;

1. a vending machine (100) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further operable in response to determining that insufficient change is available (see figure 8a, element 820), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 8a, element 822) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount. Therefore, any amount above the item price is predetermined to be an overpay.)
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 1b, noting processor (144) which necessarily allows input and storage of item prices);

As described in Claims 8, 17 and 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figure 8a, elements (820 and 822));

7. Claims 8-10, 12, 14-18, 20, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsey et al (US 6,055,521). Ramsey et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20, 26 and 29;

1. a vending machine (35) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further operable in response to determining that insufficient change is available (see figures 5, 15a and 15b), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend, depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount. Therefore, any amount above the item price is predetermined to be an overpay.)
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (note that PC (27) necessarily allows input and storage of item prices);

As described in Claims 8, 17, 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figures 5, 15a and 15b);

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 8-20 and 25-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 8-20 and 25-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255 in view of Morun. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application. In addition, the claims of Morun disclose an overpayment process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

11. Applicant's arguments filed 2/21/02 have been fully considered but they are not persuasive. Regarding Independent Claims 8, 16, 17, 20, 25 and 29, Morun discloses a display (95) which is capable of being used for displaying information. Morun also discloses dispensing a lesser amount of change (see element 1004 in figure 9, for example), or inhibiting a vend (see elements 1001 and 1002 of figure 9). At the very least, it would have been obvious for one ordinarily skilled in the art to use the display means provided by Morun to display such information as it would be expected that in order for the system of Morun to work, it is necessarily so that information would have to be displayed before and after a transaction. For example, note Morun abstract, lines 7-11, col. 2, lines 9-32, col. 9, lines 58-67 and col. 12, lines 16-19. In addition, note Gustin et al (US 5,987,439), figure 20H, for example, which indicates determination of a

Art Unit: 3653

transaction amount, comparing this amount to credit available in an account or by cash, and indicating a similar process as Applicant's. Note also, Gustin et al, figure 21F, for example, indicating the transaction price and amount inserted into the machine. This screen could be construed as a warning to a customer that less than the transaction amount has been deposited. See also figure 16a, elements 522, 528 and 536 may also be construed as warnings that are used before, during and after a transaction has been made. Note that figure 17 discloses elements (572, 576, 578, 580, and 586 which may all be construed as warnings or indications to the customer during the transaction process, where he is given the ability to change an amount of cash to receive. Further regarding Claim 20, note that it would again be expedient for one ordinarily skilled in the art to allow a customer to choose another product based upon the information necessarily required for the process of Morun to work, since it can be envisioned that a customer, instead of paying a certain amount over a particular price for a particular product, might choose another product not requiring an overpay amount. Regarding Claim 25, it would also be obvious to one ordinarily skilled in the art to provide an overpay amount which would be in response to one particular coin, since, for example, the one dollar US coin has been used in vending machines. At the very least, as inflation over time causes prices to rise, it would be envisioned that a vending machine would have to accept one dollar coins in order to be more efficient to a customer attempting to purchase higher-priced items.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weston et al, Kobayashi et al, Kurowski et al and Molano et al are all cited as examples of vending transaction systems.

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

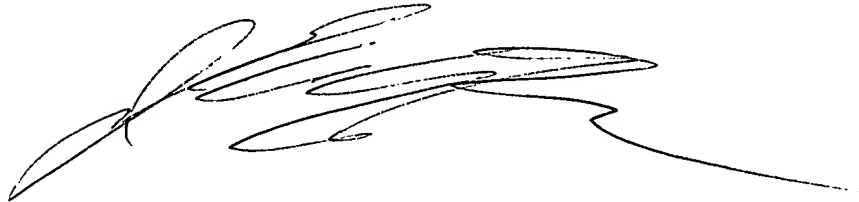
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on 9:00 AM - 5:00 PM.

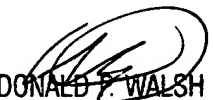
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)-306-4173. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-308-2571 for regular communications and (703)-308-2571 for After Final communications.

Art Unit: 3653

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3653



DONALD F. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

April 30, 2002